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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/944,315
Filing Date: August 31, 2001
Appellant(s): MASTERS ET AL

Joel Miller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 4, 2004.

(1) *Real Party in Interest*

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A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-19 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

6,401,859

Widmer et al

06-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-6, 8-9, 11-19 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on March 16, 2004.

Regarding claims 1 and 13, Widmer teaches a textured hearing instrument shell (figs. 4-24).

Regarding claim 2, Widmer teaches a hearing instrument comprising a textured outer surface portion, wherein the portion is inserted in the ear of a user (figs. 4-24).

Regarding claim 3, Widmer teaches the hearing instrument texture is non-smooth (figs. 4-10).

Regarding claim 5, Widmer teaches the texture comprises a series of lines, unequally spaced (figs. 7-10).

Regarding claim 6, Widmer teaches the texture comprises a predetermined or randomly generated pattern (figs. 9-10, 13-14).

Regarding claims 8-9 and 11-12, see the rejections of claims 2-6 respectively.

Regarding claim 14, Widmer teaches a hearing instrument comprising a textured outer surface portion made by a process comprising laser (col. 3 line 60 through col. 4 line 34).

Regarding claim 15, Widmer teaches a hearing instrument comprising an outer surface fabricated as a series of layers, and a textured outer surface portion made by a process comprising applying a waveform (laser application, col. 3 line 60 through col. 4 line 34) to the edges of one or more of the layers during the fabrication process (claim 3).

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Regarding claim 16, Widmer teaches a hearing instrument comprising an outer textured surface made by a process comprising: a mold cavity fabrication derived from surface contours of user's ear (col. 14 line 64 through col. 16 line 4); and modifying the mold cavity to create texture in the outer surface (col. 3 line 60 through col. 4 line 34).

Regarding claims 17-18, see the rejection of claims 2-6, 14, and 15.

Regarding claim 19, see the rejection of claims 2-6, and 16.

Claims 4, 7, 10 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on March 16, 2004.

Regarding claims 4 and 10, Widmer does not teach or restrict the finish applied to the hearing instrument. Furthermore, the examiner takes official notice that it is known for hearing instruments to be made with a variety of finishes, such as non-reflective, reflective, glow-in-the-dark, neon, glossy, etc. for aesthetic appeal to the hearing aid wearer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the hearing aid with any of a variety of finishes for aesthetic desirability to the user. For example, some hearing aid wearers do not desire to have their hearing aid(s) noticeable by others, so they choose a flesh color, such as beige as camouflage.

Regarding claim 7, Widmer does not teach incorporating a faceplate onto the hearing instrument (figs. 4-23) comprising a textured outer surface; however, the examiner takes official notice that it is known to include a textured faceplate onto a hearing instrument for housing external components such as volume control, battery, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to incorporate a faceplate onto the hearing aid instrument for housing external components.

(11) Response to Argument

With respect to the appellant's arguments that *the Widmer reference does not disclose, teach or suggest a textured surface, the examiner disagrees with this statement.*

The Manual of Patent Examination Practice clearly defines the way to properly interpret a term presented in a claim as such: (MPEP 2111.01 [R-1]) The words of a claim must be given "plain meaning" unless they are defined in the specification. While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning **unless applicant has provided a clear definition in the Specification**. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below); MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001) One must bear in mind that, especially in nonchemical cases, the words in a claim are generally not limited in their meaning by what is shown or disclosed in the specification. It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970).

"Plain meaning" refers to the meaning given to the term by those of ordinary skill in the art. **When not defined by applicant in the specification, the words of a claim**

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must be given their plain meaning. In other words, they must be read as they would be interpreted by those of ordinary skill in the art. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001)(explaining the court's analytical process for determining the meaning of disputed claim terms); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999).

In this instance, the appellant defines a textured surface in his specification on pages 2 and 5.

Excerpt page 2, *"By creating a textured, non-smooth finish on the outer shell of a hearing instrument, the hearing instrument will more readily lodge and remain within the ear canal. Furthermore, the textured finish has an appearance closer to that of natural skin and therefore, the hearing instrument is less noticeable to others, blending in with the visible portions of the ear.*

Excerpt page 5, *"A variety of textures may be utilized with hearing instrument shells. The texture may be a series of lines..., equally or unequally spaced..., or a plurality of shapes (e.g. ovals and circles...), or some other pattern, predetermined or randomly generated."*

The appellant's specification teaches that the texture, or surface composition, of the hearing shell is composed of a series of lines, shapes, and/or etc., on the surface. The

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Widmer reference (figures 4-24, column 6 lines 13-22, and the multiple channel configurations outlined and taught in the patent) clearly supports this limitation and the definition presented in the specification by the appellant. In these figures, the Widmer reference teaches both interior and exterior lines (channels) on the surface of the hearing aid shell.

Furthermore, in the certification of Martin W. Masters, paper no. 21, entered March 2, 2004 and indicated in paper 22 by the examiner as being insufficient to support appellant's assertion, it is stated by the Marks' Standard Handbook for Mechanical Engineers, 9th ed., 1987, pages 13-77 that "the standard does not specify the surface texture suitable for any particular application, nor the means by which it may be produced or measured. Neither are the standards concerned with other surface qualities such as ...luster, color, ... or any of which may be governing design consideration."

In addition the appellant states that the textured finish, or outward aesthetic appeal, has an "appearance" of natural skin for the purpose of blending in with the visible portion of the ear. This limitation is not included in the claim language and the Mark's Standard Handbook for Mechanical Engineers clearly states that appearance qualities such as appearance, luster, color, etc., is not a concern of surface-texture standards (pages 13-77).

With respect to the official notice statement of claims 4 and 10, the appellant has not argued the non-reflective finish. However, Westone Laboratories "Earmold Colors & Materials" is known for producing non-glare (non-reflective) satin finish earmolds of

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various colors including flesh tones, such as beige, light brown, medium brown, and dark brown (http://www.westone.com/hhc/hhp_colors.html).

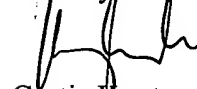
With respect to the official notice statement of claim 7, the appellant has not argued the faceplate having a textured outer surface. However, the Woodfill, Jr. reference (5,321,757) included in the Information Disclosure Statement (Paper no. 5, submitted June 30, 2003) teaches including textured in the form of a plurality of shapes on the outer surface of a faceplate in the form of a microphone 41, battery compartment door 45, and control switch 44 which is an accepted practice in-the-ear (ITE) hearing aid shell construction.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

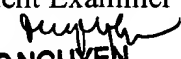
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